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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/763,210 | 01/26/2004 | Noboru Yamaji | Q79353 | 6561 |

23373 7590 06/23/2006
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EXAMINER

PAK, YONG D

ART UNIT PAPER NUMBER

1652

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|------------------------------|--|
| Office Action Summary | Application No. 10/763,210 | Applicant(s) YAMAJI ET AL | |
| | Examiner Yong D. Pak | Art Unit 1652 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 12-17 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This application is a divisional of 10/009,332, now issued as US 6,716,613, which is a 371 of PCT/JP00/07917.

The preliminary amendment filed on January 26, 2004, canceling claims 1-11 has been entered.

Claims 12-17 are pending.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 12, drawn to an antibody against a metalloprotease of SEQ ID NO:1 or its variants.

Group II, claim(s) 13, drawn to a method for screening for inhibitors of a metalloprotease of SEQ ID NO:1 or its variants.

Group III, claim(s) 14, drawn to a pharmaceutical composition for inhibiting degradation of proteoglycans using a metalloprotease of SEQ ID NO:1 or its variants.

Group IV, claim(s) 15, drawn to a method for treating a joint disease by administering a compound obtained by the method of Group II.

Group V, claim(s) 16, drawn to a polynucleotide of SEQ ID NO:24-31, wherein 1 to 1-nucleotide residues are modified and wherein said polynucleotide has joint disease aggrecanase promoter activity.

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Group VI, claim(s) 17, drawn to a method for screening a substance capable of inhibiting aggrecanase promoter activity using a cell transformed with the polynucleotide of Group V.

Applicants are required to elect ONE polynucleotide sequence selected from SEQ ID NOs: 24-31. This is not an election of species. The polynucleotides of SEQ ID NOs: 24-31 have different structure and function and also are independent chemical entities and require independent search in the patent and non-patent literature. Therefore, the polynucleotides of SEQ ID NOs:24-31 do not share a special technical feature.

The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Groups I-VI do not relate to a single general inventive concept, a special technical feature that is common to all the groups, but each of the groups are drawn to its own special technical feature as illustrated below.

The special technical feature of Group I is an antibody.

The special technical feature of Group II is a method for screening for inhibitors of a metalloprotease of SEQ ID NO:1 or its variants.

The special technical feature of Group III is a pharmaceutical composition for inhibiting degradation of proteoglycans.

The special technical feature of Group IV is a method for treating a joint disease by administering a compound.

The special technical feature of Group V is a polynucleotide of SEQ ID NO:24-31, wherein 1 to 1-nucleotide residues are modified and wherein said polynucleotide has joint disease aggrecanase promoter activity.

The special technical feature of Group VI is a method for screening a substance capable of inhibiting aggrecanase promoter activity.

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Further, the products of Groups I, III and V do not share a special technical feature because an antibody, a polynucleotide and inhibitor are different compounds, each with its own chemical structure and function, and they have different utilities. Also, the structure of the products of Groups I, III and V cannot be predicted from the products of Groups I, III or V and the polynucleotide of Group V does not encode the antibody of Group I and the antibody of Group I cannot be encoded by a polynucleotide of Group V. The methods of Groups II, IV and VI also do not share a special technical feature with each other because the methods use products that do not share any special technical features and have different utilities and effects.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

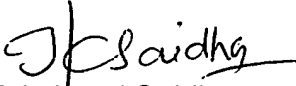
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 571-272-0935. The examiner can normally be reached 6:30 A.M. to 5:00 P.M. Monday through Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

Yong D. Pak
Patent Examiner 1652


Tekchand Saidha
Primary Patent Examiner 1652